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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/155,843 12/23/98 JOBIC

S A32002-PCTUS

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HM22/0401

EXAMINER

WEBBER, P	
ART UNIT	PAPER NUMBER

1617
DATE MAILED:

04/01/99

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/155,843

Applicant(s)

Jobic

Examiner

Bernadette S. Walker

Group Art Unit

1617

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 12-33-98 (Prelim. Amendment)
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-16 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-16 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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Claims 1-16 are pending in this application and considered below.

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim 16 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Preceding claims should be referred to in the alternative.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Norihiro et al. (JP 07149606) in view of Mariconi et al. (CA123:278677).

Norihiro et al. teach an adhesive composition comprising 5-amino-1-(2,6 dichloro-4-trifluoromethylphenyl)-3-cyano-4-trifluoromethanesulfonylpyrazol (i.e. fipronil) and vinylacetate-ethylene thermosetting copolymer.

The claims additionally designate the composition as a wood adhesive and indicate that the fipronil possesses termiticidal activity. Note that the above stated

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claims do not rely on the recited preamble for completeness because the composition is defined by its components only and not by its intended usage.

Therefore, since Mariconi et al. show the termiticidal efficacy of fipronil, it would have been obvious to one of ordinary skill in the art to formulate an inherently adhesive composition comprising fipronil and vinylacetate-ethylene copolymer to obtain formulation binding and insecticidal effect already shown in the prior art.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Norihiro et al. in view of Mariconi et al. as applied to claims 1-8 above, and further in view of Schulz et al. (CA76:73225).

Claim 9 adds the limitation that the thermosetting resin is a phenol-formaldehyde resin. To select and substitute another thermosetting resin in a fipronil based composition would have been an obvious expedient to one ordinarily skilled in the art because the selection from amongst equally suitable thermosetting resins, for use in combination with insecticide(s), is an obvious expedient.

Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Norihiro et al. in view of Mariconi et al. as applied to claim s 1-8 above, and further in view of either of Graser et al. (CA94:4756) and YOSHITOMI PHARM (JP 790060078 abs).

Claims 9 and 10 add the limitations that the thermosetting resin is selected from phenol-formaldehyde and resorcinol-formaldehyde. To select and substitute other thermosetting resins, including formaldehyde- phenol-resorcinol (shown for gluing wood by Graser et al.) and either of phenol-formaldehyde or resorcinol-formaldehyde (both

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shown as plywood adhesives by YOSHITOMI PHARM), in an insecticidal fipronil based composition would have been an obvious expedient to one of ordinary skill in the art because the selection of other equally suitable resins which are thermosetting for combination with fipronil (as with Norihiro et al.) would have been within the skill of the art.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Norihiro et al. in view of Mariconi et al. and further in view of Schulz et al.

Norihiro et al., Mariconi et al. and Schulz et al. are applied as above.

The claim differs in reciting active ingredient concentrations.

It would have been obvious to one ordinarily skilled in the art to formulate the wood adhesive shown by Norihiro et al. as modified by Mariconi et al. and Schulz et al. because the determination of active agent concentration is seen to be an obvious optimization of result oriented variables in otherwise obvious compositions.

Claims 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kodama et al. (US pat. #5,747,519) and SUMITOMO CHEM (JP 810122148 abs).

Kodama et al. teach a method of controlling pests (such as termites) comprising treating plywood, furniture, particle boards, etc. (Column 4, lines 13-18; column 1, lines 65-67) with fipronil in thickening or bonding carriers (column 4, lines 5-9; claims 1 and 11).

The claims differ in 1) limiting the wood to be treated to layers bound by the insecticidal adhesive, and 2) reciting resultant insecticide concentrations. Note that the

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determination of active agent concentration is seen to be an obvious optimization of a result oriented variable in an otherwise obvious product.

Since SUMITOMO CHEM show plywood plates bound together with an insecticidal adhesive comprising formaldehyde-urea or formaldehyde-melamine (disclosed as suitable and equivalent to thermosetting resins presently employed - page 6 of the specification), it would have been obvious to form layers of wood bound by fipronil-containing adhesive because such is seen to be a selection from amongst equally suitable insecticides, use in conjunction with resins known to be wood adhesives.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela S. Webber whose telephone number is (703) 308-4427. The examiner can normally be reached on Monday-Thursday from 8:30 AM to 6:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Adams, can be reached on (703) 308-0570. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

psw *psw*

March 4, 1999


DONALD E. ADAMS
SUPERVISORY PATENT EXAMINER